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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,907	09/05/2003	Valerie De La Poterie	05725.1236-00	6821

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EXAMINER	
VENKAT, JYOTHSNA A	

ART UNIT	PAPER NUMBER
1615	

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02/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/654,907	DE LA POTERIE ET AL.	
	Examiner	Art Unit	
	JYOTHSNA A. VENKAT Ph. D	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *30 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-117* is/are pending in the application.

4a) Of the above claim(s) *25-78 and 108-117* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24 and 79-107* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/29/05;1/11/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Receipt is acknowledged of election of species filed on 7/30/07 and election of groups filed on 1/11/07 and IDS filed on 1/11/07 and 6/29/05. Claims 1-117 are pending in the application and the status of the application is as follows:

Election/Restrictions

1. Applicant's election with traverse of group I in the reply filed on 1/11/07 is acknowledged. The traversal is on the ground(s) that the Examiner has not shown that examining Groups I-VII together would constitute a serious burden the Examiner contends that the above related groups can also be distinct, but does not specify what serious burden will be placed on the Examiner if she were to proceed in examining the groups together, as required by M.P.E.P. § 803 and all the groups are in same class. This is not found persuasive because the restriction between groups I-VII is in compliance with MPEP. § 803 and the groups may be in class 424 subclass 70.1, but the groups are drawn to separate and distinct inventions since group's I-II are drawn to cosmetic composition for coating keratin fibers. Group I has wax as the active ingredient and group II has at least on specific compound, which can be dextrin esters or fillers. Art antiicpating wax would not anticipate or render obvious either dextrin fatty esters or fillers. Therefore it s is search burden to examine both the groups drawn to compositions. It is also search burden to examine groups III-VI since art anticipating or rendering a composition claim would not anticipate or render obvious method of use claims or apparatus.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 25-78 and 108-117 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking

claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/11/07.

3. Applicant's election with traverse of species drawn to wax (kester wax 82 P) and carnauba wax as the additional wax in the reply filed on 7/30/07 is acknowledged. The traversal is on the ground(s) that the examiner has failed to show that the search and examination of a claim would impose serious burden. This is not found persuasive because it is a search burden to examine all the waxes in the patent and non-patent literature.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-24 and 79-107 are pending in the application. The claims will be examined to the extent that it reads on kesterwax 82 P (INCI name synthetic wax) and carnauba wax as the additional wax.

Priority

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e), Applicant must provide a certified English translation of the provisional applications. Further, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition

must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(0 are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-24, 85-100, 102-107 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 6,875,245 ('245).

6. The filing date of the instant application is 9/5/03 since the provisional applications are in French.

7. See table 15 drawn to "transfer resistant mascara".

8. See claimed species, synthetic wax, and carnauba wax as the additional wax, bees wax is another wax claimed in claim, isododecane is the volatile oil, and alkyl silicone resin reads on

the claimed film former. The weight percent disclosed in the example is within the claimed range for all the waxes, volatile oil and film former. Iron oxide reads on the additive (dye stuff) claimed in claim 102 and the example meets claim 103 since the composition does not have UV-screening agent. The wax claimed is same to that disclosed and therefore claims 2-9, 15-20 are also anticipated by patent. See paragraphs 31-33 for measuring the tack of wax. PTO is not equipped to measure the tack of wax; therefore patent anticipates claims 2-9 and 15-20.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-24 and 79-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 6,875, 245 ('245).

12. Patent '245 as discussed above. Patent '245 teaches personal care products and teaches amphiphilic compound (surfactants), fatty phase, which includes claimed non-volatile oil,

additives at col.15, line 50 through col.16 and teaches film forming polymers at col.19, lines 32 through col.21, line 40 and teaches at col.21 line 41 through col.23, line 52 compositions that can be formulated as a mascara... hair care products (see col.23, ll 40-45). See also examples. Patent '245 thus teaches the limitations claimed in claims 89-92 and also 79-84 at col.21, line 56 through col.22, lines 1-3. See also examples for various cosmetic products.

13. Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions by using three waxes taught in table 15 and also add aqueous phase, surfactant, non-volatile oil into the compositions since patent '245 teaches that the compositions can also have these ingredients. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A. VENKAT Ph. D/
Primary Examiner, Art Unit 1615
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